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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,031	04/13/2004	Francisco Faoro	ZIM0346	3384
7590 John F. Hoffman, Esq. BAKER & DANIELS LLP Suite 800 111 East Wayne Street Fort Wayne, IN 46802			EXAMINER PRIDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			04/03/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/823,031

**Applicant(s)**

FAORO, FRANCISCO

**Examiner**

Michael B. Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 10-23 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20040623.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 5, lines 2-3, "planar pressure surface" is not supported by the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7 and 10-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuke et al. (WO 01/85038). Tuke et al. teach an apparatus 1 for the preparation of a femoral condyle for the insertion of monocondylar knee implants, comprising a spreading device (2, 3, 4, 7...) for the setting of a desired spacing between a femoral condyle and an oppositely disposed tibia plateau and comprising at least one functional attachment 11 couplable in a vertically adjustable manner with the spreading device; wherein the spreading device includes a spreading section (4, 6, 7, 9...), which can be introduced between the femoral condyle and the tibia plateau and which extends substantially perpendicular to the spreading direction, and a handling section 3 for the

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spreading section which includes an angle  $\alpha > 90^\circ$  with the spreading section, and wherein the functional attachment supports a cutting and/or drilling jig and is adjustable at least vertically relative to the spreading device when the desired spacing is set at the handling section 3 by means of the spreading device (claim 1); wherein the spreading device includes a lower part 4 supportable at the tibia plateau, and upper part 7 adjustably guided at the lower part 4 and an actuation member 17 adjustably held at the lower part 4 which cooperates with the lower part 4 and the upper part 7 such that a setting movement of the actuation member 17 can be translated into a spreading movement of the upper part 7 away from the lower part 4 (claim 2); wherein the upper part 7 is able to be acted on from below via the actuation member 17 and can be pressed away from the lower part in the spreading direction (claim 3); wherein the actuation member 17 is adjustable obliquely to the spreading direction and the upper part 7 is adjustable parallel to the spreading direction relative to the lower part (claim 4); wherein the lower part 4 and the upper part 7 each have a plate-shaped spreading tongue with which the lower part 4 is supported at the tibia plateau and the upper part 7 can be pressed toward the femoral condyle (claim 7); wherein the spreading device is provided with a display device 65, by means of which a desired height of the functional attachment dependent on the thickness of the tibia implant to be inserted can be read off at the spreading device (claim 10); wherein the functional attachment 11 is adjustable between discrete positions relative to the spreading device which are spaced apart corresponding to the thicknesses of a set of tibia implants of different thickness (claim 11); wherein the spreading device is movable relative to the knee in the condition

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arranged between the tibia plateau and the femoral condyle, in particular substantially displaceable perpendicular to the spreading direction and/or rotatable about an axis extending substantially parallel to the spreading direction (claim 12); wherein the spreading device is couplable to a plurality of differently formed functional attachments (claim 13); wherein at least one functional attachment 11 is made as a combined cutting and drilling jig (the Examiner asserts a drill could be supported by the exterior surface above slot 12) for fixing the position of a condylar cut/bore which is to be carried out when the knee is in extension/flexion and which in particular extends substantially parallel to the tibia plateau (claims 14-17); wherein the at least one functional attachment is capable of being fixed to the femoral condyle (claim 18); wherein the functional attachment includes a body section extending obliquely to the spreading direction in the state coupled to the spreading device, couplable to the spreading device and having a fixing device 46 and a head section 49 fixedly connected to the body section which is formed as a cutting and/or as a drilling jig or as a support for a separate cutting and/or drilling jig (claim 19); wherein the head section 49 is made as a cutting jig with a slot 12 for a cutting tool defining a cutting plate and extending perpendicular to the spreading direction in the state coupled to the spreading device (claim 20); wherein the head section 49 is made as a support for a separate cutting jig 89 (claims 21 & 23) which is adjustable along the head section (claim 22).

Concerning the language of claim 12, it should be noted that anything not fixedly attached to a knee is "substantially displaceable perpendicular to the spreading

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direction and/or rotatable about an axis extending substantially parallel to the spreading direction.”

Concerning the language of claim 19 requiring “a body section extending obliquely to the spreading direction,” it is noted that a portion of functional attachment 11 between fixing device(s) 46 and slot 12 is depicted as being oblique to the spreading direction (as a truncated corner).

### ***Allowable Subject Matter***

Claims 5, 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy

*Michael B. Priddy*  
March 27, 2007

*[Signature]*  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER